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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,332	07/21/2004	Renato Ancorotti	3687-70	8959
23117	7590	06/28/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			AHMED, HASAN SYED	
			ART UNIT	PAPER NUMBER
			1615	
DATE MAILED: 06/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/500,332		ANCOROTTI, RENATO	
	Examiner		Art Unit	
	Hasan S. Ahmed		1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/28/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Receipt is acknowledged of applicant's IDS filed on 28 June 2004.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "at least fats." This phrase is grammatically incorrect, as it does not particularly point out the minimum number of fats being referred to.

Claim 6 recites the limitation "emulsion." There is insufficient antecedent basis for this limitation in the claim. Based on the antecedent basis for this claim, the limitation should read "fatty emulsion." Appropriate correction is requested

Claim 7 recites the limitations "matte or pearly." It is unclear what these limitations are referring to.

Claim 10 recites the limitation "fatty emulsion." There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "as above." It is unclear which claims this phrase is referring to.

Claim 11 recites the limitation "(c)." There is insufficient antecedent basis for this limitation in the claim.

Claims 15 and 16 are indefinite because they lack an article.

Claim 17 provides for the use of the product, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Verdon, et. al. (U.S. Patent No. 4,994,264).

Verdon, et. al. disclose a press molded cosmetic composition (see col. 1, line 67 – col. 2, line 2).

The disclosed composition is the instant composition as claimed:

- the paste (see col. 2, line 1; Example, col. 4, line 65 – col. 5, line 23) comprising: (1) the fats (see Example, col. 4, line 65 – col. 5, line 23); (2) the coloring powders (see col. 3, lines 54-58); (3) the solvent (see col. 2, lines 41-44); and (4) the drying step (see col. 4, line 63) of instant claim 1;
- the paste comprising at least one fatty emulsion in a solvent with coloring powders of instant claim 2 (see Example, col. 4, line 65 – col. 5, line 23);
- the fatty acids of instant claim 3 (see Example, col. 4, line 65 – col. 5, line 23);
- the stearate of instant claim 4 (see Example, col. 4, line 65 – col. 5, line 23);
- the water of instant claim 5 (see col. 2, lines 41-44);
- the preserving agents of instant claim 6 (see col. 3, lines 63-66);
- the coloring powders comprising synthetic and/or natural pigments of instant claim 7 (see col. 3, lines 54-58);
- the drying temperature range of instant claim 8 (see col. 4, lines 32-36);

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- the further modification of dimensions and/or shape of instant claim 9 (see col. 4, lines 28-32);
- the process of claim 10 (see Example, col. 4, line 65 – col. 5, line 23);
- the extruding into various shapes and sizes of instant claim 11 (see col. 4, lines 11-13);
- the ratio of phases of instant claim 12 (see col. 6, line 20);
- the cosmetic of instant claim 15 (see Example, col. 4, line 65 – col. 5, line 23);
- the blusher or eye shadow of instant claim 16 (see col. 1, line 17); and
- the use as a cosmetic of instant claim 17 (see col. 1, lines 14-17).

The drying processes of instant claims 13 and 14 are not essential to a determination of patentability of the composition disclosed in the claim. As explained by the court in *In re Thorpe et. al.* (CAFC 1985) 779 F2d 695, "A claim to a composition defined by reference to the process by which it is produced, is not limited to compositions produced by the process recited in the claim."

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600